

REMARKS

The Examiner has rejected all of the pending claims, Claims 9, 10, 12-17, 22, and 39-49, under 35 USC 103(a) as being obvious in view of Fukuo et al. (US 6,203,910). The Examiner indicated that Example 4 of Fukuo et al teaches the use of dipropylene glycol monomethyl ether in combination with propylene glycol monomethyl ether, and asserted that "replacing the disclosed propylene glycol monomethyl ether with propylene glycol monobutyl ether would give the combination claimed by Applicants". The only bases set forth by the Examiner for making such a replacement is that these are solvents that are mere homologues of each other, and that "The reference itself suggests substitutions of monobutyl ether for mono methyl ether by equating the two in comparative example 1 and 2.". However, as discussed below, no *prima facie* showing of obviousness can be established on the basis of the Fukuo et al. reference.

First, there is no mention in Fukuo et al. about "propylene glycol monobutyl ether." The use of this compound is in no way taught as part of the disclosure of Fukuo. Moreover, the Examiner's reliance on Comparative examples 1 and 2 of Fukuo et al. is misplaced. These examples disclose "ethylene glycol monobutyl ether" and "ethylene glycol monomethyl ether." In contrast, the issue at hand is the substitution of propylene glycol monobutyl ether for propylene glycol monomethyl ether. "Propylene glycol" and "ethylene glycol" are very different compounds, and the effect in the case of "propylene glycol" would not necessarily be expected from that of "ethylene glycol."

Additionally, Comparative Examples 1 and 2 actually make clear that "monobutyl" ether is different from "monomethyl" ether. As can be seen in Table I of Fukuo et al., the result of Comparative example 1 in which the "monobutyl" compound was used is quite different from the result of Comparative example 2 in which "monomethyl" was used. Therefore, the Fukuo reference actually fails to suggest the equivalence of monobutyl ether and monomethyl ether because quite different results are achieved.

Therefore, the cited reference not only fails to teach all the elements of the claims, it also fails to provide any reason to create the substitutions suggested by the Examiner. Therefore a *prima facie* case of obviousness has not been established, and the claims should be allowed on this basis alone.

Furthermore, even if a *prima facie* case of obviousness could be established, it would be rebutted by the unexpected results achieved by the presently claimed invention. Applicant

submits a Declaration by Hidetoshi Fukuo, one of the co-inventors, which shows that the excellent properties (wet-surface writing properties in particular) cannot be obtained by following the disclosure of the Fukuo et al. reference.

As detailed in the Declaration, a "comparative example" solid composition based on the solvents disclosed in Example 4 of the Fukuo et al. patent was compared to a solid composition corresponding to the claimed invention (Example 5). Both compositions were evaluated for their wet-face writing properties. It is apparent from Table A of the Declaration that the solid composition using the combination of "propylene glycol monomethyl ether" and "dipropylene glycol monomethyl ether" cannot achieve the desirable wet-surface writing properties of the presently claimed invention.

These results could not have been expected based on the teachings of the prior art Fukuo et al. reference. These unexpected results would rebut any *prima facie* showing of obviousness, even were such a showing created on the basis of the Fukuo et al. patent.

CONCLUSION

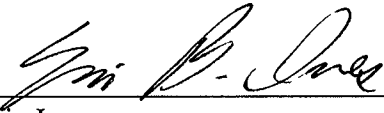
In view of the above, the claims are now believed to be fully in condition for allowance. Reconsideration and withdrawal of all outstanding rejections are respectfully requested. Allowance of the claims at an early date is solicited. If any points remain that can be resolved by telephone, the Examiner is invited to contact the undersigned at the below-given telephone number.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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